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ASSEMBLY

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**PROPOSED AMENDMENTS OF THE PCT REGULATIONS AND
MODIFICATIONS OF THE PCT ADMINISTRATIVE INSTRUCTIONS,
RELATING TO THE DRAFT PATENT LAW TREATY**

Document prepared by the International Bureau of WIPO

INTRODUCTION

1. This document¹ contains proposals for amendments of the Regulations under the PCT and modifications of the Administrative Instructions under the PCT.² While the proposals concern directly the processing of international applications under the PCT, they are made with particular regard to the draft Patent Law Treaty (PLT) that has been under development by the WIPO Standing Committee on the Law of Patents (SCP) and will be submitted as the basic proposal to the Diplomatic Conference for the Adoption of the Patent Law Treaty ("PLT Diplomatic Conference") to be held in Geneva from May 11 to June 2, 2000.³

2. The main purpose of the proposals in this document, so far as the PCT procedure is concerned, is to provide the possibility for applicants, when filing an international application, to satisfy in a simplified way a number of requirements of national⁴ law which presently have to be met when the application enters the national phase of processing. In particular, applicants would have the possibility of satisfying certain requirements set out in Rule 51*bis*, as proposed to be amended, by way of making one or more of four declarations in the request, as provided for in proposed amendments of Rule 4, which must use standardized wordings prescribed in the Administrative Instructions. Those declarations relate to the identity of the inventor, the applicant's entitlement to apply for and be granted a patent, the applicant's entitlement to claim priority in certain circumstances, and a declaration of inventorship for the purposes of the designation of the United States of America. A standardized wording is also provided for a declaration as to non-prejudicial disclosures and exceptions to lack of novelty.

3. The draft PLT is designed to streamline and harmonize the procedural and administrative requirements of national patent Offices for the filing and processing of national patent applications. Those procedural and administrative requirements include the form and contents of national patent applications, the type of translations of documents which an applicant may be required to provide to an Office in the course of processing an application, and the evidence which an applicant may be required to provide to an Office in the course of processing an application.

¹ This and other working documents for the Assembly's session are available on WIPO's Internet site at http://www.wipo.int/eng/document/govbody/wo_pct/index_28.htm.

² References in this document to "Articles," "Rules" and "Sections" are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT ("the Regulations") and of the Administrative Instructions under the PCT ("the Administrative Instructions"), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO's Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>.

³ References in this document to "draft PLT Articles," "draft PLT Rules" and "draft PLT Notes" are, respectively, to those of the draft Patent Law Treaty (PLT) contained in the basic proposal for submission to the Diplomatic Conference for the Adoption of the Patent Law Treaty to be held in Geneva from May 11 to June 2, 2000 ("PLT Diplomatic Conference") (document PT/DC/3), of the draft Regulations under the Patent Law Treaty ("draft PLT Regulations") contained in the basic proposal (document PT/DC/4), and of the Explanatory Notes on the basic proposal (document PT/DC/5). See WIPO's Internet site at http://www.wipo.int/eng/document/pt_dc/index.htm.

⁴ References in this document to "national law," "national applications," "national Offices," etc., include reference to regional law, regional applications, regional Offices, etc.

4. Although the draft PLT is applicable primarily to national patent applications, it incorporates by reference the standards prescribed by the PCT as to the form and contents of international applications. The proposals in this document are in line with the goal of the draft PLT to streamline administrative requirements, and the proposals take into account discussions by the SCP of related matters in connection with the draft PLT.

5. The proposed amendments of the Regulations and modifications of the Administrative Instructions are contained, respectively, in Annexes I and II to this document. Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. In a small number of cases, text the need for which, or the precise wording of which, is in doubt is included in square brackets. Parts of affected Rules which are not proposed to be amended are also included where they are particularly relevant to the provisions proposed to be amended; if they are not included, they are replaced by the indication “[No change]”. Comments are included, immediately following the text of the provisions concerned, where it seems that they would be helpful. Draft texts for inclusion in the Notes to the request form are also included in order to explain how the declarations should be completed in practice.

6. The proposed modifications of the Administrative Instructions are included in this document (as Annex II) for the purposes of consultation under Rule 89.2(b).

7. The proposals are based on those considered by the PCT Committee for Administrative and Legal Matters (“PCT/CAL”)⁵ (in documents PCT/CAL/7/2 to 5) at its seventh session held in Geneva from November 29 to December 3, 1999, revised as necessary in the light of the conclusions and discussion by that Committee (see the Committee’s report in document PCT/CAL/7/6). In addition to the changes agreed by PCT/CAL (as set out in Annexes III and IV to document PCT/CAL/7/6), a number of further drafting changes to the proposals have been made by the International Bureau, notably in the numbering of certain provisions and in the wording of proposed Rule 4.17 (which appears as proposed Rules 4.17 to 4.19 in Annex III to document PCT/CAL/7/6) and proposed amended Rule 51*bis*.2 (which appears as proposed Rule 51*bis*.1(a-*bis*), (a-*ter*) and (a-*quater*) in Annex III to document PCT/CAL/7/6). Those further drafting changes are mentioned in the comments following the provisions concerned in Annex I to this document.

8. A more detailed discussion of the proposals is given in the following paragraphs, as follows:

- (i) *documents and evidence which may be required under national law;*
- (ii) *contents of the international application;*
- (iii) *correction and addition of declarations;*
- (iv) *communication and publication of declarations;*
- (v) *certified translations of international applications;*
- (vi) *translations of priority documents;*
- (vii) *opportunity to comply with national requirements;*
- (viii) *indications concerning registered applicants and agents.*

⁵ See WIPO’s Internet site at http://www.wipo.int/eng/meetings/1999/pct/index_7.htm.

DOCUMENTS AND EVIDENCE WHICH MAY BE REQUIRED
UNDER NATIONAL LAW

9. Article 27(1) provides: “No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.” Article 27(2)(ii) specifically enables the national law to require, once the processing of the international application has started in the designated Office, the furnishing of “documents not part of the international application but which constitute proof of allegations or statements made in that application.” In relation to substantive matters, as distinct from matters of form or contents, Article 27(6) provides: “The national law may require that the applicant furnish evidence in respect of any substantive condition of patentability prescribed by such law.” The relevant provisions of the Regulations for the purposes of Article 27 are found in present Rule 51*bis*.

10. Present Rule 51*bis*.1(a) lists a number of matters relating to which the applicant may be required to furnish documents or evidence under the national law applicable by the designated Office. Although that list is not exhaustive, it provides clarity for both applicants and designated Offices that such items may be required to be furnished by the applicant under the national law applicable by the designated Office.

11. It is proposed to amend Rule 51*bis*.1(a) to clarify the items listed, consistently with Article 27 and with national laws. The *chapeau* in the Rule is proposed to be amended to refer to Article 27 in general. In addition, several items listed in the Rule are proposed to be re-worded, certain items are proposed to be combined, and one item is proposed to be added, in order to provide clarity as to the substance of what an applicant may be required to furnish and to provide consistency with the amendments proposed to Rule 4 (see below). The matters listed in items (i) to (vi) of proposed amended Rule 51*bis*.1(a) relating to which a designated Office may require further evidence or additional documents include: the identity of the inventor; the applicant’s entitlement to apply for or be granted a patent; the applicant’s entitlement to claim priority where that applicant is not the applicant who filed the earlier application the priority of which is claimed or where the applicant’s name has changed since the date on which the earlier application was filed; (in certain cases) an oath or declaration of inventorship; non-prejudicial disclosures or exceptions to lack of novelty; and (in certain cases) any government license rights in the invention. Only the item relating to government license rights is entirely new (Rule 51*bis*.1(a)(vi)).

12. Draft PLT Article 6(6) provides that a Contracting Party may require that evidence be filed with its Office in the course of processing the application only where that Office may reasonably doubt the veracity of any matter contained in the application. It is similarly proposed to amend Rule 51*bis* to conform to those proposals in the draft PLT regarding the circumstances under which a designated Office may require an applicant to furnish evidence or additional documents regarding statements made in the international application.

13. Consistent with the approach taken in the draft PLT, it is proposed to limit the ability of a designated Office to require evidence from an applicant under the PCT where the applicant has included a declaration under proposed amended Rule 4.17(i) to (iv). Such a limitation would apply regardless of whether the applicant has filed the declaration together with the international application or furnished the declaration under proposed new Rule 26*ter* after the filing of the international application. Such a limitation is also proposed where the applicant has submitted directly to a designated Office a declaration in accordance with proposed amended Rule 4.17, relating to events which occurred prior to the international filing date.

However, where the designated Office has reasonable doubts as to the veracity of the declaration submitted by the applicant, the designated Office may require the applicant to furnish evidence or additional documents.

14. It is similarly proposed to limit the ability of a designated Office to require the applicant to furnish evidence or additional documents regarding the identity of an inventor where indications regarding the inventor have already been furnished in the request in accordance with Rule 4.6, unless the designated Office has reasonable doubts as to the veracity of the indications.

15. A designated Office would not be subject to such a limitation for declarations referred to in Rule 4.17(v) as to non-prejudicial disclosures or exceptions to lack of novelty, noting that such matters involve substantive conditions of patentability.

16. Since proposed Rule 51*bis*.2(a) may not be compatible with all national laws applicable by designated Offices, it is proposed to provide the ability for Offices to make a transitional reservation regarding its applicability, as provided in proposed Rule 51*bis*.2(c).

17. The draft PLT sets forth certain maximum requirements for national patent applications which national patent Offices may impose on applicants. In setting those requirements, the draft PLT expressly relies on the requirements which may be imposed under the PCT. Specifically, draft PLT Article 6(1) provides:

“(1) [*Form or Contents of Application*] Except where otherwise provided for by this Treaty or prescribed in the Regulations, and subject to paragraph (6), no Contracting Party shall require compliance with any requirement relating to the form or contents of an application different from or additional to:

(i) the requirements relating to form or contents which are provided for in respect of international applications under the Patent Cooperation Treaty;

(ii) the requirements relating to form or contents compliance with which, under the Patent Cooperation Treaty, may be required by the Office of, or acting for, any Contracting State of that Treaty once the processing or examination of an international application, as referred to in Article 23 or Article 40 of the said Treaty, has started;

(iii) any further requirements prescribed in the Regulations.”

18. The requirements relating to the form or contents of an international application which a designated Office may impose under the PCT are thus incorporated by reference under the draft PLT as permissible requirements which national Offices may impose in respect of national applications. The requirements concerned include, in particular, those which apply under Rule 51*bis*.

CONTENTS OF THE INTERNATIONAL APPLICATION:
DECLARATIONS USING STANDARDIZED WORDING

19. At present, a PCT applicant has the opportunity to satisfy the national requirements which are expressly set forth in Rule 51*bis*.1(a) only upon or after entry of the international application into the national phase of the PCT procedure, that is, when the designated Office begins to process it. The proposals contained in this document are designed to afford applicants the possibility of satisfying those requirements at the time of filing an international application or later during the international phase.

20. It is proposed to permit applicants to include in the request certain declarations corresponding to the matters set out in Rule 51*bis*.1(a)(i) to (v), relating to which designated Offices may require evidence or documents. In particular, the proposals would provide applicants with the possibility in certain circumstances of making, in the request, declarations using standardized wording set out in the Administrative Instructions as to: the identity of the inventor; the applicant's entitlement to apply for and be granted a patent; the applicant's entitlement to claim priority of an earlier application; an oath or declaration as to inventorship; and non-prejudicial disclosures or exceptions to lack of novelty (see, respectively, proposed Rules 4.17(i) to (v) and the declarations set out in proposed Sections 211 to 215).

21. The declarations referred to in Rule 4.17 could only be made in cases where the circumstances are capable of being covered by the standardized wording that is prescribed; in other cases, the applicant would not be able to include such declarations and may be required to furnish documentary evidence to designated Offices in the national phase, as provided for by Article 27 and Rule 51*bis*.1. Where a declaration using standardized wording is made, however (other than a declaration as to non-prejudicial disclosures or exceptions to lack of novelty), no designated Office would be entitled, in the national phase, to require the applicant to furnish further evidence as to the matter covered by the declaration, except where there is a reasonable doubt as to the veracity of the declaration (see proposed Rule 51*bis*.2). Thus, where the standardized wordings are appropriate to the circumstances, applicants could include the necessary declarations in the request at the time of filing the international application and avoid having to file with a number of designated Offices, when entering the national phase, multiple similar declarations covering the matters concerned.

22. It is thus proposed to amend Rule 4.1(c) to provide that the request may contain declarations as provided in Rule 4.17(i) to (v), which relate to the matters referred to in Rule 51*bis*.1(a)(i) to (v), respectively. All of those declarations are subject to the requirement that they conform to the standardized wording set out in Sections 211 to 215. In addition, an oath or declaration of inventorship made for the purposes of the designation of the United States of America under Rule 4.17(iv) and Section 214 would have to be signed by the person making it if that person did not sign the request.

23. The proposals also address related issues concerning the correction and addition to the request of such declarations, and their publication and/or communication to designated Offices.

CORRECTION AND ADDITION OF DECLARATIONS

24. In general, it is proposed under Rule 26*ter*.1 to permit applicants to correct or add to the request any declaration referred to in Rule 4.17 until the expiration of 16 months from the priority date (or even later, provided that the declaration is received by the International Bureau before the technical preparations for international publication have been completed).

25. Pursuant to proposed Section 214, a declaration of inventorship referred to in Rule 4.17(iv) which is corrected or added under Rule 26*ter*.1 would have to be signed by the person concerned.

26. Proposed Rule 26*ter*.2(a) provides that the receiving Office or the International Bureau may invite the applicant to correct any declaration referred to in Rule 4.17 that is not worded or signed as required. The receiving Office and the International Bureau would not, however, have to check such a declaration for its substance or its completeness; such matters would be ones for designated Offices in the national phase. Pursuant to proposed Rule 26*ter*.2(b), where the International Bureau receives a correction or addition of a declaration outside the time limit under Rule 26*ter*.1, the International Bureau would notify the applicant accordingly.

27. Proposed Section 433 of the Administrative Instructions sets out procedures to be followed pursuant to proposed Rule 26*ter*.2(b). Specifically, it provides that the International Bureau shall return a declaration received outside the time limit to the applicant and inform the applicant that the declaration should be submitted to the designated Office or Offices concerned. It is envisaged that, when declarations are received and processed in electronic form, the International Bureau may be in a position to forward declarations submitted after the time limit to the designated Office or Offices concerned rather than reject them, and a corresponding modification of the Section could then be considered.

COMMUNICATION AND PUBLICATION OF DECLARATIONS

28. The declarations provided for under Rule 4.17 would provide applicants the possibility of satisfying, in the international phase, certain national law requirements set forth in Rule 51*bis*.1(a). Thus, where such a declaration is included in the request, the designated Offices concerned must be informed.

29. In order to inform designated Offices that a declaration under Rule 4.17 has been included in the request, it is proposed that such declaration be communicated by the International Bureau to the designated Offices concerned and also be mentioned in the published pamphlet (see Rules 47.1(a-*ter*) and 48.2(b)(iv)). A declaration regarding non-prejudicial disclosures or exceptions to lack of novelty (see Rule 4.17(v)) would be published as part of the pamphlet (see Rule 48.2(a)(x)) and would not be separately communicated.

CERTIFIED TRANSLATIONS OF INTERNATIONAL APPLICATIONS

30. Draft PLT Article 6(3) provides that a Contracting Party may require a translation of any part of an application that is not in a language accepted by its Office. However, draft PLT Article 6(6) provides that a Contracting Party may require that evidence be filed with its Office in the course of the processing of the application only where that Office may

reasonably doubt the accuracy of the translation. Under the draft PLT, such evidence could include a certification of the translation.

31. Draft PLT Article 6(7) also provides that, where evidence is required from an applicant, the national Office shall notify the applicant, giving an opportunity to comply with any such requirement, and to make observations, within two months from the date of the notification.

32. At present under the PCT, Rule 51*bis*.2(b) provides that the national law applicable by the designated Office may require that the applicant, upon invitation by the designated Office, furnish a certification of the translation of the international application if the designated Office deems such certification to be necessary, and that the designated Office must give the applicant an opportunity to comply with the requirement within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

33. Consistent with the approach taken in the draft PLT, it is proposed to limit the ability of a designated Office to require certification of the translation of the international application except where the designated Office reasonably doubts the accuracy of the translation. It is also proposed that if a certification of the translation is required, the designated Office must invite the applicant to provide the certification and the applicant must be given an opportunity to comply with such a requirement within not less than two months from the date of the invitation.

34. Accordingly, it is proposed to amend Rule 51*bis*.2(b) by deleting the present text and to amend Rule 51*bis*.1(d) to provide that no designated Office shall require certification of the translation of the international application by a public authority or sworn translator except where the designated Office reasonably doubts the accuracy of the translation and, upon an invitation to the applicant, gives an opportunity to comply with any such requirement within not less than two months from the date of the invitation.

TRANSLATIONS OF PRIORITY DOCUMENTS

35. Draft PLT Article 6(5) provides that, where the priority of an earlier application is claimed, a Contracting Party may require that a copy of the earlier application, and a translation where the earlier application is not in a language accepted by the Office, be filed with the Office in accordance with the Regulations under the draft PLT. Pursuant to draft PLT Rule 4(4), a Contracting Party may require such a translation only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable. Furthermore, pursuant to draft PLT Article 6(7), a Contracting Party may only require such a translation upon invitation by the national Office, within a time limit which shall be not less than two months from the date of the invitation.

36. Consistent with the approach taken under the draft PLT, it is proposed to limit the ability of designated Offices to require that a translation of a priority document be furnished by the applicant to those cases where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable.

37. Accordingly, proposed new Rule 51*bis*.1(e) provides that the national law applicable by the designated Office may, in accordance with Article 27(6), require that a translation of the priority document be furnished in the language, or in one of the languages of, or a language

admitted by, the designated Office only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable.

38. Since proposed new Rule 51*bis*.1(e) may not be compatible with all national laws applicable by designated Offices, it is proposed to provide the ability to make a transitional reservation regarding the applicability of that proposed new Rule, as provided in proposed new Rule 51*bis*.1(f).

39. It is also proposed to make the procedure before the International Preliminary Examining Authority consistent with the approach taken in the draft PLT with respect to translation requirements. Thus, it is proposed to amend Rule 66.7(b) to restrict the entitlement of an International Preliminary Examining Authority to invite the applicant to furnish a translation of a priority document to cases where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1).

OPPORTUNITY TO COMPLY WITH NATIONAL REQUIREMENTS

40. Pursuant to draft PLT Article 6(7) read together with draft PLT Article 6(1) to (6), where one or more of the requirements applied by the Contracting Party with respect to the form and contents of an application, translations, and priority documents is not complied with, or where evidence is required from the applicant, the national Office shall notify the applicant, giving an opportunity to comply with any such requirement or provide such evidence, and to make observations, within the relevant time limit. Pursuant to draft PLT Rule 6(1), the time limit referred to in draft PLT Article 6(7) shall be not less than two months from the date of the notification.

41. At present under the PCT, Rule 51*bis*.2(a) provides that where any of the requirements referred to in Rule 51*bis*.1, or any other requirement of the national law applicable by the designated Office which that Office may apply under Article 27(1), (2), (6) or (7), is not already fulfilled prior to the beginning of national phase processing, the applicant shall have an opportunity to comply with that requirement once national phase processing has begun. However, under the present Rule, a designated Office is not required to invite the applicant to comply with the national requirement and there is no guaranteed amount of time within which the applicant may have the opportunity to comply with such requirement.

42. Consistent with the approach taken by the draft PLT, it is proposed in Rule 51*bis*.3(a) to require designated Offices to invite the applicant to comply with any national requirement referred to in Rule 51*bis*.1, or any other national law requirement which an Office may apply under Article 27(1) or (2), which has not already been fulfilled by the beginning of national phase. It is also proposed that applicants be given not less than two months from the date of the invitation to comply with such national requirement. In recognition of the extra administrative burden placed on designated Offices by the proposed invitation requirement, a designated Office would be entitled to charge a fee for inviting the applicant to comply with national requirements. The provisions of present Rule 51*bis*.2(a) in relation to Article 27(6) and (7) would be relocated as Rule 51*bis*.2(b).

INDICATIONS CONCERNING REGISTERED APPLICANTS AND AGENTS

43. Draft PLT Rule 10(1)(a)(iii) provides that a Contracting Party may require any communication to a national Office to contain, where the applicant, owner or other interested person is registered with the Office, the number or other indication under which he is so registered. Draft PLT Rule 10(1)(b)(iii) makes a similar provision with respect to representatives (agents).

44. Consistent with the draft PLT, it is proposed to add a new Rule 4.5(e) to provide that, where the applicant is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the applicant is so registered. It is also proposed to add a new Rule 4.7(b) to provide that, where the agent is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the agent is so registered.

45. By virtue of Rule 53.5, indications relating to registration of applicants and agents would also be able to be included in a demand for international preliminary examination.

ENTRY INTO FORCE

46. The amendments to the PCT Regulations proposed in this document would require some time to be implemented completely. Procedures, forms and informational materials relating to the international phase would need to be reviewed and modified, as well as the applicable national law and practice in many designated Offices. It is therefore proposed that the amendments would enter into force on March 1, 2001, and that they would apply only in respect of international applications filed on or after that date.

47. The Assembly of the PCT Union is invited:

(i) to adopt the proposed amendments to the Regulations under the PCT as appearing in Annex I to this document and to decide that they will enter into force on March 1, 2001, and that they will apply only in respect of international applications filed on or after March 1, 2001;

(ii) to note that the Director General intends to promulgate modifications of the Administrative Instructions based on Annex II to this document, taking into account consultations pursuant to Rule 89.2(b) during the Assembly's session and subsequently, with effect from March 1, 2001.

[Annex I follows]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS⁶

Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) and (b) [No change]

(c) The request may contain:

(i) [No change]

(ii) a request to the receiving Office to prepare and transmit the priority document to the International Bureau where the application whose priority is claimed was filed with the national Office or intergovernmental authority which is the receiving Office_;

[COMMENT: The proposed amendment would bring the wording of Rule 4.1(c)(ii) into line with that of Rule 17.1(b).]

(iii) declarations as provided in Rule 4.17.

(d) [No change]

⁶ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Provisions which are not proposed to be amended are also included where they are particularly relevant to the provisions proposed to be amended; if they are not included, they are replaced by the indication “[No change]”.

[Rule 4.1, continued]

[COMMENT: Proposed Rules 4.1(c)(iii) and 4.17, together with proposed Sections 211 to 215, are intended to provide applicants with the possibility of including in the request declarations relating to certain matters about which designated Offices are entitled to require documents or evidence in the national phase of processing of the international application. Those matters are set out in Rule 51bis.1(a), which is also proposed to be amended. For applicants to make use of this possibility, any such declaration in the request must conform to the standard wording set out in proposed Sections 211 to 215. If a declaration as to such a matter is included in the request, designated Offices are limited, by proposed Rule 51bis.2, in their ability to require documents or evidence in the national phase to cases where the designated Office has reasonable doubts about the veracity of statements made in the declaration. Such declarations, if not included in the request when the international application is filed, may be added later under proposed Rule 26ter.1, which also provides for corrections of such declarations. See proposed Rule 26ter.2 as to the processing of such declarations. As to the publication or communication to designated Offices of declarations, see proposed Rules 47.1(a-ter) and 48.2(a)(x) and (b)(iv). The wording of proposed Rule 4.1(c)(iii) as approved by PCT/CAL has been modified to reflect drafting changes made to proposed Rule 4.17.]

[DRAFT NOTE FOR REQUEST FORM: Notes along the following lines would be included in the Notes to the request form: “The various declarations which may be included in the request are set out in Rule 4.17. Only declarations which conform to the standardized wordings provided for in the Administrative Instructions may be included in the request. If the circumstances are such that those standardized wordings are not applicable, the applicant should not attempt to make use of the declarations set out in Rule 4.17 but rather will have to comply with the national requirements concerned upon entry into the national phase. The fact that a declaration is made under Rule 4.17 does not of itself establish the matters declared; those matters remain for determination by the designated Offices in accordance with the applicable national law. A designated Office is free, but is not obliged, to accept a declaration for the purposes of the applicable national law even if the wording of the declaration does not conform to the standardized wording provided for in the Administrative Instructions pursuant to Rule 4.17.”]

4.5 *The Applicant*

(a) to (d) [No change]

(e) Where the applicant is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the applicant is so registered.

[COMMENT: The proposed amendment reflects draft PLT Rule 10(1)(a)(iii). The same provision would apply mutatis mutandis, by virtue of existing Rule 53.4, to the demand for international preliminary examination in cases where the applicant is registered with the national Office that is acting as International Preliminary Examining Authority.]

4.6 *The Inventor*

(a) Where Rule 4.1(a)(v) or (c)(i) applies, the request shall indicate the name and address of the inventor or, if there are several inventors, of each of them.

[COMMENT: The proposed amendment makes it clear that the requirements of Rule 4.6 apply in relation to indications of inventors under both Rule 4.1(a)(v) and (c)(i).]

(b) and (c) [No change]

4.7 The Agent

(a) If ~~agents are designated~~ an agent is appointed, the request shall so indicate, and shall state ~~their~~ the agent's names and addresses.

[COMMENT: The proposed amendment is designed to avoid possible confusion arising from the use of the word “designated,” which has a very specific meaning in the context of the PCT (see, for example, Rule 4.9).]

(b) Where the agent is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the agent is so registered.

[COMMENT: The proposed amendment reflects draft PLT Rule 10(1)(b)(iii). The same provision would apply mutatis mutandis, by virtue of existing Rule 53.5, to the demand for international preliminary examination in cases where the agent is registered with the national Office that is acting as International Preliminary Examining Authority.]

4.8 Common Representative

If a common representative is ~~designated~~ appointed, the request shall so indicate.

[COMMENT: The proposed amendment is designed to avoid possible confusion arising from the use of the word “designated,” which has a very specific meaning in the context of the PCT (see, for example, Rule 4.9).]

4.9 to 4.16 [No change]

4.17 Declarations Relating to National Requirements Referred to in Rule 51bis.1(a)(i) to (v)

The request may, for the purposes of the national law applicable in one or more designated States, contain one or more of the following declarations, worded as prescribed by the Administrative Instructions:

(i) a declaration as to the identity of the inventor, as referred to in Rule 51bis.1(a)(i);

(ii) a declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent, as referred to in Rule 51bis.1(a)(ii);

(iii) a declaration as to the applicant's entitlement, as at the international filing date, to claim priority of the earlier application, as referred to in Rule 51bis.1(a)(iii);

(iv) a declaration of inventorship, as referred to in Rule 51bis.1(a)(iv), which shall be signed as prescribed by the Administrative Instructions;

(v) a declaration as to non-prejudicial disclosures or exceptions to lack of novelty, as referred to in Rule 51bis.1(a)(v).

[Rule 4.17, continued]

[COMMENT: Proposed Rule 4.17 sets forth those matters relating to which applicants may include a declaration in the request pursuant to proposed Rule 4.1(c)(iii). Such matters include those as to which designated Offices are entitled to require documents or evidence during the national phase of processing and which are expressly listed in Rule 51bis.1(a), which is also proposed to be amended. Proposed Sections 211 to 215 of the Administrative Instructions (Annex II to this document) prescribe the proposed standardized wording of such declarations which may be included in the request pursuant to proposed Rule 4.17. A declaration of inventorship pursuant to proposed Rule 4.17(iv) must also be signed as prescribed by proposed Section 214 of the Administrative Instructions. The wording of proposed Rule 4.17 as approved by PCT/CAL has been amended in an attempt to simplify prior proposals. In particular, proposed Rule 4.17 now encompasses all matters as to which declarations containing standardized wording may be included in the request pursuant to proposed Rule 4.1(c)(iii), whereas prior proposals had split such matters into several proposed rules.]

~~4.17~~ 4.18 *Additional Matter*

(a) The request shall contain no matter other than that specified in Rules 4.1 to ~~4.16~~ 4.17, provided that the Administrative Instructions may permit, but cannot make mandatory, the inclusion in the request of any additional matter specified in the Administrative Instructions.

(b) If the request contains matter other than that specified in Rules 4.1 to ~~4.16~~ 4.17 or permitted under paragraph (a) by the Administrative Instructions, the receiving Office shall *ex officio* delete the additional matter.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 4.17. The wording as approved by PCT/CAL has been modified to reflect drafting changes made to proposed Rule 4.17.]

Rule 26ter

Correction or Addition of Declarations Under Rule 4.17

26ter.1 Correction or Addition of Declarations

The applicant may correct or add to the request any declaration referred to in Rule 4.17 by a notice submitted to the International Bureau within a time limit of 16 months from the priority date, provided that any notice which is received by the International Bureau after the expiration of that time limit shall be considered to have been received on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

26ter.2 Processing of Declarations

(a) Where the receiving Office or the International Bureau finds that any declaration referred to in Rule 4.17 is not worded as required or, in the case of the declaration of inventorship referred to in Rule 4.17(iv), is not signed as required, the receiving Office or the International Bureau, as the case may be, may invite the applicant to correct the declaration within a time limit of 16 months from the priority date.

(b) Where the International Bureau receives any correction or addition of a declaration under Rule 26ter.1 after the expiration of the time limit under Rule 26ter.1, the International Bureau shall notify the applicant accordingly and shall proceed as provided for in the Administrative Instructions.

[Rule 26ter, continued]

[COMMENT: Proposed Rule 26ter provides procedures for the addition or correction of declarations in the request which are referred to in Rule 4.17 (see also Rules 4.1(c)(iii) and 51bis.1(a)). Proposed Rule 26ter thus provides the applicant with a simplified way of providing evidence of changes with respect to the applicant which occur during the international phase. The recording by the International Bureau of such changes during the international phase would continue to be done under Rule 92bis. It is envisaged that a single form would be promulgated on which the applicant could both request the recording of a change with respect to the applicant pursuant to present Rule 92bis and also make a declaration pursuant to proposed Rule 26ter.1. The wording of proposed Rule 26ter.2(b) as approved by PCT/CAL has been further simplified. Proposed Section 433 would establish a procedure for processing corrections or additions of declarations that are received by the International Bureau outside the time limit under Rule 26ter.2(a).]

Rule 47

Communication to Designated Offices

47.1 *Procedure*

(a) and (a-bis) [No change]

(a-ter) The notification under paragraph (a-bis) shall include any declaration referred to in Rule 4.17(i) to (iv), and any correction under Rule 26ter.1, which was received by the International Bureau before the expiration of the time limit under Rule 26ter.1, provided that the designated Office has informed the International Bureau that the applicable national law requires the furnishing of documents or evidence relating to the matter to which the declaration relates.

[COMMENT: Proposed Rule 47.1(a-ter) provides procedures for communicating any declaration referred to in Rule 4.17(i) to (iv) to designated Offices (see also Rules 4.1(c)(iii) and 51bis.1(a)). Declarations referred to in Rule 4.17(v) would be included in the published pamphlet as a result of the proposed amendments to Rule 48, below. The wording of proposed Rule 47.1(a-ter) as approved by PCT/CAL has been modified to reflect drafting changes made to proposed Rule 4.17.]

(b) to (e) [No change]

47.2 to 47.4 [No change]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (viii) [No change]

(ix) any information concerning a priority claim considered not to have been made under Rule 26bis.2(b), the publication of which is requested under Rule 26bis.2(c),

(x) any declaration referred to in Rule 4.17(v), and any correction under Rule 26ter.1, which was received by the International Bureau before the expiration of the time limit under Rule 26ter.1.

[COMMENT: Proposed Rule 48.2(a)(x) provides that the pamphlet shall contain any declaration contained in the request that is referred to in proposed Rule 4.17(v), that is, declarations regarding non-prejudicial disclosures or exceptions to lack of novelty (see Rules 4.1(c)(iii) and 51bis.1(a)(v)). The wording of proposed Rule 48.2(a)(x) as approved by PCT/CAL has been modified to reflect drafting changes made to proposed Rule 4.17.]

(b) Subject to paragraph (c), the front page shall include:

(i) and (ii) [No change]

(iii) the abstract; if the abstract is both in English and in another language, the English text shall appear first,

(iv) an indication that the request contains any declaration referred to in Rule 4.17 which was received by the International Bureau before the expiration of the time limit under Rule 26ter.1.

[COMMENT: Proposed Rule 48.2(b)(iv) provides that the front page of the pamphlet shall contain indications that the request contains any declaration referred to in proposed amended Rule 4.17. The wording of proposed Rule 48.2(b)(iv) as approved by PCT/CAL has been modified to reflect drafting changes made to proposed Rule 4.17.]

(c) to (i) [No change]

48.3 to 48.6 [No change]

Rule 51bis

Certain National Requirements Allowed Under Article 27~~(1), (2), (6) and (7)~~

51bis.1 Certain National Requirements Allowed

(a) ~~The documents referred to in Article 27(2)(ii), or the evidence referred to in Article 27(6), which the applicant may be required to furnish under the national law applicable by the designated Office include~~ Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

[COMMENT: The proposed amendments to Rule 51bis.1(a) clarify that the items set forth below may be required in accordance with Article 27 as a whole. The wording of proposed Rule 51bis.1(a) as approved by PCT/CAL has been modified to reflect drafting changes made to proposed Rule 51bis.2.]

- (i) any document relating to the identity of the inventor,

[COMMENT: See proposed Rule 4.17(i) and Section 211 as to the corresponding declaration which the applicant may include in the request. See also proposed Rule 51bis.2 for limitations as to the circumstances in which documents or evidence may be required by the designated Office.]

- (ii) any document relating to ~~any transfer or assignment of the right to the application~~ the applicant's entitlement to apply for or be granted a patent,

[COMMENT: The proposed amendments to item (ii) clarify that a designated Office may require any document relating to the applicant's entitlement to apply for or be granted a patent. See proposed Rule 4.17(ii) and Section 212 as to the corresponding declaration which the applicant may include in the request. See also proposed Rule 51bis.2 for limitations as to the circumstances in which documents or evidence may be required by the designated Office.]

[Rule 51bis.1(a), continued]

~~(iii) any document containing an oath or declaration by the inventor alleging his inventorship;~~

[COMMENT: The substance of present item (iii) is proposed to be covered by proposed item (iv), below.]

~~(iv) any document containing a declaration by the applicant designating the inventor or alleging the right to the application;~~

[COMMENT: Present item (iv) is proposed to be deleted since the subject matter covered appears to be adequately dealt with in present item (i) and proposed amended item (ii).]

~~(v) (iii)~~ any document containing any proof ~~of the right of the applicant to claim priority where he is different from the applicant having filed the earlier application the priority of which is claimed~~ of the applicant's entitlement to claim priority of an earlier application where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the date on which the earlier application was filed,

[COMMENT: Proposed amended item (iii) (deriving from present item (v)) clarifies that a designated Office may require any document containing any proof of an applicant's right to claim priority of an earlier application in certain cases. See proposed Rule 4.17(iii) and Section 213 as to the corresponding declaration which the applicant may include in the request. See also proposed Rule 51bis.2 for limitations as to the circumstances in which documents or evidence may be required by the designated Office.]

[Rule 51bis.1(a), continued]

(iv) where the international application designates a State whose national law requires that national applications be filed by the inventor, any document containing an oath or declaration of inventorship.

[COMMENT: Proposed new item (iv) contains the substance of present item (iii) and clarifies that a designated Office may require any document containing an oath or declaration of inventorship. See proposed Rule 4.17(iv) and Section 214 as to the corresponding declaration which the applicant may include in the request. See also proposed Rule 51bis.2 for limitations as to the circumstances in which documents or evidence may be required by the designated Office.]. The wording of item (iv) is the same as that approved by PCT/CAL as item(v).]

~~(vi)~~ (v) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time.

[COMMENT: The text of proposed item (v) is the same as present item (vi) and as approved by PCT/CAL as item (iv). See proposed Rule 4.17(v) and Section 215 as to the corresponding declaration which the applicant may include in the request.]

(vi) where the invention was invented as part of the work performed under a contract with the government of the designated State, any document containing a statement which indicates any government license rights in the invention and identifies the government contract.

[COMMENT: Proposed item (vi) clarifies that a designated Office may require any document containing a statement which indicates any government license rights in the invention and identifies of the government contract. The wording of the provision as approved by PCT/CAL has been further modified slightly.]

[Rule 51bis.1, continued]

(b) and (c) [No change]

(d) The national law applicable by the designated Office may, in accordance with Article 27(2)(ii), require that the translation of the international application furnished by the applicant under Article 22 be verified by the applicant or the person having translated the international application in a statement to the effect that, to the best of his knowledge, the translation is complete and faithful. No designated Office shall require certification of the translation of the international application by a public authority or sworn translator except where the designated Office reasonably doubts the accuracy of the translation.

[COMMENT: Proposed amended Rule 51bis.1(d) would preclude designated Offices from requiring certified translations except where there are reasonable doubts about the accuracy of a translation and only upon an invitation and within a minimum two-month time limit to comply with the requirement to provide such a translation. The invitation and two-month time limit to comply are consistent with draft PLT Article 6(7) and draft PLT Rule 6(1). The proposal addresses the substance of present Rule 51bis.2(b) which, consequently, is proposed to be deleted.]

(e) The national law applicable by the designated Office may, in accordance with Article 27(6), require that a translation of the priority document be furnished in the language, or in one of the languages of, or a language admitted by, the designated Office only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable.

[COMMENT: Proposed Rule 51bis.1(e) provides that designated Offices may require a translation of a priority document only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable. This proposed amendment is consistent with draft PLT Rule 4(4). See also the proposed amendments to Rule 66.7 below with respect to translations required by International Preliminary Examining Authorities.]

[Rule 51bis.1, continued]

(f) If, on March 17, 2000, paragraph (e) is not compatible with the national law applied by the designated Office, that paragraph shall not apply in respect of that Office for as long as that paragraph continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by June 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: Proposed paragraph (f) would enable designated Offices to make a transitional reservation regarding the applicability of proposed paragraph (e).]

51bis.2 Circumstances in Which Documents or Evidence May Be Required

(a) Where the applicable national law does not require that national applications be filed by the inventor, the designated Office shall not, unless it has reasonable doubts as to the veracity of the indications or declaration concerned, require any document or evidence:

(i) relating to the identity of the inventor (Rule 51bis.1(a)(i)), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request or if a declaration as to the identity of the inventor, in accordance with Rule 4.17(i), is contained in the request or is submitted directly to the designated Office;

(ii) relating to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rule 51bis.1(a)(ii)), if a declaration as to that matter, in accordance with Rule 4.17(ii), is contained in the request or is submitted directly to the designated Office;

(iii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the date on which the earlier application was filed (Rule 51bis.1(a)(iii)), if a declaration as to that matter, in accordance with Rule 4.17(iii), is contained in the request or is submitted directly to the designated Office.

[Rule 51bis.2, continued]

[COMMENT: Proposed new Rules 51bis.2(a) and (b) are intended to limit the circumstances in which designated Offices are entitled to require documents or evidence from applicants in the national phase in relation to certain matters referred to in Rule 51bis.1(a). The limitation is consistent with draft PLT Article 6(6). Rule 51bis.1(a) applies to designated Offices whose applicable national law does not require that national applications be filed by the inventor, whereas Rule 51bis.1(b) applies to designated Offices whose applicable national law does require that national applications be filed by the inventor. In practice, proposed Rule 51bis.1(a) would apply to all designated Offices except the United States Patent and Trademark Office. Under proposed item (i), if the request contains indications concerning the inventor in accordance with Rule 4.6 or a declaration as to the identity of the inventor in accordance with Rule 4.17(i), or if such a declaration is submitted directly to the designated Office, the Office would not be entitled to require documents or evidence regarding the identity of the inventor unless the Office has reasonable doubts as to the veracity of the indications contained in the request or the declaration. Under proposed item (ii), if the request contains a declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent in accordance with Rule 4.17(ii), or if such a declaration is submitted directly to the designated Office, the Office would not be entitled to require documents or evidence regarding the applicant's entitlement unless the Office has reasonable doubts as to the veracity of the declaration. Under proposed item (iii), if the request contains a declaration in accordance with Rule 4.17 (iii) as to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application in certain situations, or if such a declaration is submitted directly to the designated Office, the Office would not be entitled to require documents or evidence regarding the applicant's entitlement unless the Office has reasonable doubts as to the veracity of the declaration. Note that proposed Rule 51bis.2(a) does not apply in relation to declarations of inventorship or declarations regarding non-prejudicial disclosures or exceptions to lack of novelty referred to in Rule 4.17(iv) and (v), respectively. The proposed Rule as approved by PCT/CAL has been renumbered (the subject matter appeared previously in proposed Rule 51bis.1(a-bis)) and its overall structure has been further amended in an effort to clarify and simplify its wording.]

[Rule 51bis.2, continued]

(b) Where the applicable national law requires that national applications be filed by the inventor, the designated Office shall not, unless it has reasonable doubts as to the veracity of the declaration concerned, require any document or evidence:

(i) relating to the identity of the inventor (Rule 51bis.1(a)(i)) (other than a document containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request;

(ii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the date on which the earlier application was filed (Rule 51bis.1(a)(iii)), if a declaration as to that matter, in accordance with Rule 4.17(iii), is contained in the request or is submitted directly to the designated Office;

(iii) containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if a declaration of inventorship, in accordance with Rule 4.17(iv), is contained in the request or is submitted directly to the designated Office.

[COMMENT: Proposed new Rule 51bis.2(b), like proposed Rule 51bis.2(a), is intended to limit the circumstances in which designated Offices are entitled to require documents or evidence from applicants in the national phase in relation to certain matters referred to in Rule 51bis.1(a). The limitation is consistent with draft PLT Article 6(6). Rule 51bis.1(b) applies to designated Offices whose applicable national law require that national applications be filed by the inventor, whereas Rule 51bis.1(a) applies to designated Offices whose applicable national law does not require that national applications be filed by the inventor. In practice, proposed Rule 51bis.1(b) would apply only to the United States Patent

[Rule 51bis.2, continued]

and Trademark Office as a designated Office. Under proposed item (i), if the request contains indications concerning the inventor in accordance with Rule 4.6 or a declaration as to the identity of the inventor in accordance with Rule 4.17(i), the designated Office would not be entitled to require documents or evidence regarding the identity of the inventor (other than an oath or declaration of inventorship) unless the Office has reasonable doubts as to the veracity of the indications contained in the request or the declaration. Under proposed item (ii), if the request contains a declaration in accordance with Rule 4.17 (iii) as to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application in certain situations, or if such a declaration is submitted directly to the designated Office, the Office would not be entitled to require documents or evidence regarding the applicant's entitlement unless the Office has reasonable doubts as to the veracity of the declaration. Under proposed item (iii), if the request contains a declaration of inventorship in accordance with Rule 4.17 (iv), or if such a declaration is submitted directly to the designated Office, the Office would not be entitled to require documents or evidence regarding the applicant's entitlement unless the Office has reasonable doubts as to the veracity of the declaration. Note that proposed Rule 51bis.2(b) does not apply in relation to declarations as to the identity of the inventor or declarations regarding non-prejudicial disclosures or exceptions to lack of novelty referred to in Rule 4.17(i) and (v), respectively. The proposed Rule as approved by PCT/CAL has been renumbered (the subject matter appeared previously in proposed Rule 51bis.1(a-ter)) and its overall structure has been further amended in an effort to clarify and simplify its wording.]

(c) If, on March 17, 2000, paragraph (a) is not compatible, in relation to any item of that paragraph, with the national law applied by the designated Office, paragraph (a) shall not apply in respect of that Office in relation to that item for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by June 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: Proposed new Rule 51bis.2(c) would enable designated Offices to make a transitional reservation regarding the applicability of any matter referred to in Rule 51bis.2(a). The wording of the provision approved by PCT/CAL (then numbered as proposed Rule 51bis.1(a-quater)) has been further simplified.]

~~51bis.2~~ 51bis.3 *Opportunity to Comply with National Requirements*

(a) Where any ~~of the requirements referred to in Rule 51bis.1, or any other~~ requirement of the national law applicable by the designated Office which that Office may apply ~~under~~ in accordance with Article 27(1), or (2), ~~(6) or (7)~~, is not already fulfilled during the same period within which the requirements under Article 22 must be complied with, ~~the applicant shall have an opportunity to comply with the requirement after the expiration of that period~~ the designated Office shall invite the applicant to comply with the requirement within a time limit which shall not be less than two months from the date of the invitation. Each designated Office may require that the applicant pay a fee for complying with national requirements in response to the invitation.

[COMMENT: Proposed Rule 51bis.3(a) provides that designated Offices shall invite the applicant to comply with those requirements of national law which designated Offices may apply under Article 27(1) and (2) which have not already been fulfilled by the time of entry into the national phase. Consistent with draft PLT Articles 6(3), 6(6) and 6(7), the proposal also provides for a minimum two-month time limit to comply with such requirements. In order to ease the administrative burden which the invitation procedure places on designated Offices, the proposal further provides that designated Offices may require the payment of a fee for complying with national requirements in response to the invitation. Matters which fall under Articles 27(6) and (7) are not subject to the invitation procedure and are addressed below in the proposed Rule 51bis.3(b). The proposal as approved by PCT/CAL has been renumbered, having appeared previously as proposed amended Rule 51bis.2(b), and its manner of presentation has been simplified.]

[Rule 51bis.3, continued]

(b) ~~The national law applicable by the designated Office may, in accordance with Article 27(2)(ii), require that the applicant, upon invitation by the designated Office, furnish a certification of the translation of the international application by a public authority or a sworn translator, if the designated Office deems such certification to be necessary under the circumstances, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.~~ Where any requirement of the national law applicable by the designated Office which that Office may apply in accordance with Article 27(6) or (7) is not already fulfilled during the same period within which the requirements under Article 22 must be complied with, the applicant shall have an opportunity to comply with the requirement after the expiration of that period.

[COMMENT: The text of present Rule 51bis.2(b) is proposed to be deleted since the possibility to require a certified translation of the international application is now included in proposed amended Rule 51bis.1(d). Proposed Rule 51bis.3(b) provides that applicants shall have an opportunity to comply with those requirements of national law which designated Offices may apply under Article 27(6) and (7) which have not already been fulfilled by the time of entry into the national phase. This proposal as approved by PCT/CAL has been renumbered, having appeared previously as proposed amended Rule 51bis.2(a), and its manner of presentation has been simplified.]

[Rule 51bis.3, continued]

(c) If, on March 17, 2000, paragraph (a) is not compatible with the national law applied by the designated Office in relation to the time limit referred to in that paragraph, the said paragraph shall not apply in respect of that Office in relation to that time limit for as long as the said paragraph continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by June 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: Proposed Rule 51bis.3(c) would enable designated Offices to make a transitional reservation regarding the applicability of the time limit referred to in proposed amended Rule 51bis.3(a).]

Rule 53

The Demand

51.3 to 51.4 [No change]

53.5 Agent or Common Representative

If an agent or common representative is ~~designated~~ appointed, the demand shall so indicate. Rules 4.4 and 4.16 shall apply, and Rule 4.7 shall apply *mutatis mutandis*.

[COMMENT: The proposed amendment is designed to avoid possible confusion arising from the use of the word “designated,” which has a very specific meaning in the context of the PCT (see, for example, Rule 4.9).]

53.6 to 53.9 [No change]

Rule 66

**Procedure Before the
International Preliminary Examining Authority**

66.1 to 66.6 [No change]

66.7 Priority Document

(a) [No change]

(b) If the application whose priority is claimed in the international application is in a language other than the language or one of the languages of the International Preliminary Examining Authority, that Authority may, [where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33\(1\)](#), invite the applicant to furnish a translation in the said language or one of the said languages within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary examination report may be established as if the priority had not been claimed.

[COMMENT: The proposed amendment to Rule 66.7 provides that the International Preliminary Examining Authority may invite the application to furnish a translation of the priority document where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1).]

66.8 and 66.9 [No change]

[Annex II follows]

ANNEX II

PROPOSED MODIFICATIONS OF THE
ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT⁷

Section 211

Declaration Identifying the Inventor

Any declaration as to the identity of the inventor, referred to in Rule 4.17(i), shall be worded as follows:

“Declaration (in relation to international application No. ...) identifying the inventor (Rules 4.17(i) and 51bis.1(a)(i)), in a case where the declarations under Rule 4.17(ii) and (iv) are not appropriate:

(i) ... (name) of ... (address) is the inventor of the subject matter for which protection is sought by way of (the) (this) international application

(ii) this declaration is made for the purposes of (include as applicable):

(a) all designations (except the designation of the United States of America)

(b) the following designations (, except the designation of the United States of America,) for national and/or regional patents ...”

⁷ Proposed additions are indicated by underlining the text concerned. In a small number of instances, text the need for which, or the precise wording of which, is in doubt is included in square brackets.

[Section 211, continued]

[COMMENT: Proposed Section 211 provides standardized wording for a declaration as to the identity of the inventor (see Rules 4.17(i) and 51bis.1(a)(i)). Such a declaration would be used in cases where the inventor is not indicated as such in the request under Rule 4.6 and where the inventor is not also indicated as applicant (in which case Rule 4.17(ii) would apply). As to the declaration of inventorship for the purposes of the designation of the United States of America, see Section 214. The wording of Section 211 as approved by PCT/CAL has been modified to reflect drafting changes made in Rule 4.17.]

[DRAFT NOTE FOR REQUEST FORM: Notes along the following lines would be included the request form: “A declaration in accordance with Rule 4.17(i) is not necessary in respect of any inventor who is indicated as such in Box II or III in accordance with Rule 4.6. A declaration in accordance with Rule 4.17(i) is also not necessary where the inventor is indicated as the applicant in Box II or III in accordance with Rule 4.5, but, in such a case, the declaration under Rule 4.17(ii) may be appropriate for the purposes of all designated States except the United States of America. For details as to the oath or declaration by the inventor of inventorship required by the United States of America as a designated State, see Rule 4.17(iv) and the relevant part of these Notes. Ellipses and words in parentheses indicate that information is required to be inserted. More than one inventor may be named in a single declaration, or separate declarations may be made. The wording may be adapted from the singular to the plural as necessary. Declarations may be corrected or added under Rule 26ter after the filing of the international application. Any such correction or addition should be submitted with a letter signed by the applicant as provided in Rule 92.1. For details as to national law requirements regarding identification of inventors, see the relevant National Chapters in the PCT Applicant’s Guide, Volume II.”]

Section 212

**Declaration as to Applicant's Entitlement
to Apply for and Be Granted a Patent**

Any declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent, referred to in Rule 4.17(ii), shall be worded as follows, with such inclusion, omission, repetition and re-ordering of the matters listed as items (i) to (viii) as is necessary to explain the applicant's entitlement:

"Declaration (in relation to international application No. ...) as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rules 4.17(ii) and 51bis.1(a)(ii)), in a case where the declaration under Rule 4.17(iv) is not appropriate:

... (name) is entitled to apply for and be granted a patent by virtue of the following:

(i) ... (name) (of ... (address)) is the inventor of the subject matter for which protection is sought by way of (the) (this) international application

(ii) ... (name) is (was) entitled as employer of the inventor, ... (inventor's name)

(iii) an agreement between ... (name) and ... (name), dated ...

(iv) an assignment from ... (name) to ... (name), dated ...

[Section 212, continued]

- (v) consent from ... (name) in favor of ... (name), dated ...

- (vi) a court order issued by ... (name of court), effecting a transfer from ... (name)
to ... (name), dated ...

- (vii) other transfer of entitlement from ... (name) to ... (name) by way of ...
(specify kind of transfer), dated ...

- (viii) the applicant's name changed from ... (name) to ... (name) on ... (date)

- (ix) this declaration is made for the purposes of (include as applicable):
 - (a) all designations (except the designation of the United States of America)

 - (b) the following designations (, except the designation of the United States
of America,) for national and/or regional patents ..."

[COMMENT: Proposed Section 212 provides standardized wording for a declaration as to the applicant's entitlement to apply for and be granted a patent (see Rules 4.17(ii) and 51bis.1(a)(ii)). As to the declaration of inventorship for the purposes of the designation of the United States of America, see Section 214. The wording of Section 212 as approved by PCT/CAL has been modified to reflect drafting changes made in Rule 4.17.]

[Section 212, continued]

[DRAFT NOTE FOR REQUEST FORM: Notes along the following lines would be included the request form: “Include only those items which are applicable, omitting those which do not apply. Ellipses and words in parentheses indicate that information is required to be inserted. In connection with item (vii), other possible kinds of transfer of entitlement include merger, acquisition, inheritance, donation, etc. Where there has been a succession of transfers from the inventor, the order in which transfers are listed should follow the actual succession of transfers, and items may be included more than once, as necessary to explain the applicant’s entitlement. More than one person may be named in a single declaration, or separate declarations may be made. The wording may be adapted from the singular to the plural as necessary. Declarations may be corrected or added under Rule 26ter after the filing of the international application. Any such correction or addition should be submitted with a letter signed by the applicant as provided in Rule 92.1. For details as to national law requirements regarding the applicant’s entitlement to apply for and be granted a patent, see the relevant National Chapters in the PCT Applicant’s Guide, Volume II. For details as to the oath or declaration of inventorship required by the United States of America as a designated State, see Rule 4.17(iv) and the relevant part of these Notes.”]

Section 213

**Declaration as to Applicant's Entitlement
to Claim Priority of Earlier Application**

Any declaration as to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application, referred to in Rule 4.17(iii), shall be worded as follows, with such inclusion, omission, repetition and re-ordering of the matters listed as items (i) to (viii) as is necessary to explain the applicant's entitlement:

"Declaration (in relation to international application No. ...) as to the applicant's entitlement, as at the international filing date, to claim priority where the applicant is not the applicant who filed the earlier application from which priority is claimed or where the applicant's name has changed since the filing of the earlier application (Rules 4.17(iii) and 51bis.1(a)(iii)):

... (name) is entitled to claim priority of earlier application No. ... by virtue of the following:

(i) ... (name) is (was) entitled as employer of the inventor, ... (inventor's name)

(ii) an agreement between ... (name) and ... (name), dated ...

(iii) an assignment from ... (name) to ... (name), dated ...

(iv) consent from ... (name) in favor of ... (name), dated ...

[Section 213, continued]

(v) a court order, issued by (name of court), effecting a transfer from ...
(name) to ... (name), dated ...

(vi) other transfer of entitlement from ... (name) to ... (name) by way of ...
(specify kind of transfer), dated ...

(vii) the applicant's name changed from ... (name) to ... (name) on ... (date)

(viii) the applicant is the inventor of the subject matter for which protection was
sought by way of the earlier application"

(ix) this declaration is made for the purposes of (include as applicable):

(a) all designations

(b) the following designations for national and/or regional patents ..."

[COMMENT: Proposed Section 213 provides standardized wording for a declaration as to the applicant's entitlement to claim the priority of an earlier application in respect of which the name of the applicant was not the same as in the international application claiming priority (see Rules 4.17(iii) and 51bis.1(a)(iii)). The wording of Section 213 as approved by PCT/CAL has been modified to reflect drafting changes made in Rule 4.17.]

[Section 213, continued]

[DRAFT NOTE FOR REQUEST FORM: Notes along the following lines would be included the request form: “This declaration is only applicable where the person or name of the applicant is different from that of the applicant who filed the earlier application from which priority is claimed. Include only those items which are applicable, omitting those which do not apply. Ellipses and words in parentheses indicate that information is required to be inserted. In connection with item (vi), other possible kinds of transfer of entitlement include merger, acquisition, inheritance, donation, etc. Where there has been a succession of transfers from the applicant in respect of the earlier application, the order in which transfers are listed should follow the actual succession of transfers, and items may be included more than once, as necessary to explain the applicant’s entitlement. More than one person may be named in a single declaration, or separate declarations may be made. The wording may be adapted from the singular to the plural as necessary. Declarations may be corrected or added under Rule 26ter after the filing of the international application. Any such correction or addition should be submitted with a letter signed by the applicant as provided in Rule 92.1. For details as to national law requirements regarding the applicant’s entitlement to claim priority of an earlier application, see the National Chapters in the PCT Applicant’s Guide, Volume II.”]

Section 214

Declaration of Inventorship

(a) A declaration of inventorship, referred to in Rule 4.19, that is furnished for the purposes of the designation of the United States of America shall be worded as follows:

“Declaration of inventorship (Rules 4.17(iv) and 51bis.1(a)(iv)):

I hereby declare that I am the original, first and sole (if only one inventor is listed) or joint (if more than one inventor is listed) inventor of the subject matter which is claimed and for which a patent is sought.

This declaration is directed to the international application of which it forms a part (if filing declaration with application).

This declaration is directed to international application No. PCT/... (if furnishing declaration pursuant to Rule 26ter).

I hereby state that I have reviewed and understand the contents of the description, claims and drawings of said application. I have identified in the request of said application any claim to foreign priority, and I have identified below, under the heading “Prior Applications,” any application for a patent or inventor’s certificate filed in a country other than the United States of America and having a filing date prior to the filing date of the earliest filed application in the request or prior to the international filing date (if no priority is claimed).

[Section 214, continued]

I hereby acknowledge the duty to disclose information that is known by me to be material to patentability as defined by 37 C.F.R. § 1.56.

Further, if this international application is a continuation-in-part application of a prior United States application for patent, I acknowledge the duty to disclose information that is known by me to be material to patentability as defined by 37 C.F.R. § 1.56 which became available between the filing date of the prior application and the international filing date of the present application. (This paragraph may be omitted if the international application is not a continuation-in-part application of a prior United States application.)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name: ...

Residence: ...

[Section 214, continued]

Post Office Address: ...

Citizenship: ...

Prior Applications: ...

Signature: ... (if not contained in the request, or if declaration is corrected or added under Rule 26ter after the filing of the international application)

Date: ... (of signature which is not contained in the request, or of the declaration that is corrected or added under Rule 26ter after the filing of the international application)”

(b) Any correction or addition under Rule 26ter.1 of a declaration referred to in paragraph (a) shall take the form of a declaration referred to in that paragraph and be signed by the inventor. In addition, any such correction shall be entitled “Supplemental declaration of inventorship (Rules 4.17(iv) and 51bis.1(a)(iv)).”

[COMMENT: Proposed Section 214 provides standardized wording for an oath or declaration of inventorship (Rules 4.17(iv) and 51bis.1(a)(iv)) for the purposes of the designation of a State whose national law requires that national applications be filed by the inventor (in practice, the only such State is the United States of America. The wording of Section 214 as approved by PCT/CAL (then numbered as proposed Section 215) has been modified to reflect drafting changes to Rule 4.17.]

[Section 214, continued]

[DRAFT NOTE FOR REQUEST FORM: Notes along the following lines would be included the request form: “Words in parentheses indicate instructions to the inventor, and ellipses indicate information which is required to be inserted. All inventors should be named in a single declaration, and bibliographic data, such as address of residence and citizenship, must be included for each inventor. Such a declaration may be added pursuant to Rule 26ter after the filing of an international application. For an oath or declaration filed with the international application, the inventor need not sign and date the oath or declaration if he has signed the request. However, for an oath or declaration corrected or added after the filing of an international application, the inventor must sign the oath or declaration. Any such correction or addition should be submitted with a letter signed by the applicant as provided in Rule 92.1.”]

Section 215

Declaration as to Non-Prejudicial Disclosures
or Exceptions to Lack of Novelty

Any declaration as to non-prejudicial disclosures or exceptions to lack of novelty, referred to in Rule 4.17(v), shall be worded as follows, with such inclusion, omission, repetition and re-ordering of the matters listed as items (i) to (iv) as is necessary:

“Declaration (in relation to international application No. ...) as to non-prejudicial disclosures or exceptions to lack of novelty (Rules 4.17(v) and 51 *bis*.1(a)(v)):

... (name) declares that [an] [the] invention that is the subject of (the) (this) international application was disclosed as follows:

(i) kind of disclosure (include as applicable):

(a) international exhibition

(b) publication

(c) abuse of [a] [the] claimed invention

(d) other: ... (specify)

(ii) date of disclosure: ...

[Section 215, continued]

(iii) title of disclosure (if applicable): ...

(iv) place of disclosure (if applicable): ...

(v) this declaration is made for the purposes of (include as applicable):

(a) all designations

(b) the following designations for national and/or regional patents ...”

[COMMENT: Proposed Section 215 provides standardized wording for a declaration as to non-prejudicial disclosures or exceptions to lack of novelty (see Rules 4.17(v) and 51bis.1(a)(v)). The wording of Section 215 as approved by PCT/CAL (then numbered as proposed Section 214) has been modified to reflect drafting changes made in Rule 4.17.]

[DRAFT NOTE FOR REQUEST FORM: Notes along the following lines would be included the request form: “Ellipses and words in parentheses indicate that information is required to be inserted or that items are to be included only if applicable to a given factual situation. More than one applicant may be named in a single declaration, or separate declarations may be made. The wording may be adapted from the singular to the plural as necessary. Declarations may be corrected or added under Rule 26ter after the filing of the international application. Any such correction or addition should be submitted with a letter signed by the applicant as provided in Rule 92.1. For details on national law requirements regarding non-prejudicial disclosures or exceptions to lack of novelty, see the relevant National Chapters in the PCT Applicant’s Guide, Volume II.”]

Section 433

Processing of Declarations Under Rule 26ter.2

Where a declaration referred to in Rule 4.17, or any correction thereof under Rule 26ter.1, is submitted to the International Bureau after the time limit under Rule 26ter.1, the International Bureau shall notify the applicant accordingly, returning the declaration to the applicant and informing the applicant that the declaration should be submitted directly to the designated Office or Offices concerned.

[COMMENT: Proposed Section 433 provides the procedure for processing declarations which are received by the International Bureau after the time limit set forth in proposed Rule 26ter.1, and, in particular, provides that the International Bureau shall inform the applicant that the declaration should be submitted directly to the designated Office or Offices concerned.]

[End of Annex and of document]